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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,447	02/04/2002	Paul J. Smith	UTL 00151	7551

7590 06/19/2002  
Kyocera Wireless Corp.  
Attn: Patent Department  
PO Box 928289  
San Diego, CA 92192-8289

EXAMINER

LEON, EDWIN A

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/067,447

Applicant(s)

SMITH ET AL.

Examiner

Edwin A. León

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a PWB" in Line 3. It is not clear if this PWB is the same as the one recited in Line 2 or a different one.

Claim 10 recites the limitation "a PWB" in Line 3. It is not clear if this PWB is the same as the one recited in Lines 1-2 or a different one.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips, II (U.S. Patent No. 5,239,135). With regard to Claim 1, Phillips, II discloses a recessed

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fastener adapter device comprising: a board interface (11,13); and a fastener head engaging surface (top of 19 and 11). See Figs. 1-3.

The limitations “for recessing a fastener on a printed wire board (PWB)”, “for interfacing the adapter device with a PWB at a fastener hole”, and “for accepting and recessing a fastener head” have not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 2, Phillips, II discloses the board interface (11,13) including a tube (11,13) with an exterior surface, wherein a flange (11) extends radially outward from the exterior surface, and wherein the flange (11) has an upper surface. See Figs. 1-3.

The limitation “for interfacing with a PWB” has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 3, Phillips, II discloses the fastener head engaging surface (top of 19 and 11) including the tube (11,13) having a closed end (lower part of 15) with a bore (Fig. 1). See Figs. 1-3.

The limitation “for engaging a fastener head and passing a fastener shaft attached to a fastener head” has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 4, Phillips, II discloses the board interface (11,13) including a tube (11,15) with an exterior surface, wherein a flange (11) extends radially outward from the exterior surface, and wherein the flange (11) has a lower surface (17,29). See Figs. 1-3.

The limitation “for interfacing with a PWB” has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 5, Phillips, II discloses the fastener head engaging surface (top of 19 and 11) including the tube (11,15) having a closed end (lower part of 15) with a bore (Fig. 1). See Figs. 1-3.

The limitation “for engaging a fastener head and passing a fastener shaft attached to a fastener head” has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 6, Phillips, II discloses the board interface (11,13) including a tube (11,15) with an exterior surface; and, wherein the fastener head engaging surface (top of 19 and 11) including the tube (11,15) having a closed end (lower part of 15) with a stepped bore (Fig. 1). See Figs. 1-3.

The limitation "for interfacing with a PWB" and "for engaging a fastener head and passing a fastener shaft attached to a fastener head" has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 7, Phillips, II discloses the tube (11,15) exterior surface having a protrusion (11). See Figs. 1-3.

The limitation "for interfacing with a PWB" has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Claim 8, Phillips, II discloses a step in the tube (11,15) exterior surface forms the protrusion (11). See Figs. 1-3.

With regard to Claim 9, Phillips, II discloses the tube (11,15) exterior surface being grooved (17). See Figs. 1-3.

With regard to Claim 10, Phillips, II discloses a system, the system comprising: a PWB (23) having a fastener hole (31), a top surface (25), and a bottom surface; and, a recessed fastener adapter including: a board interface (11,13); and, a fastener head engaging surface (top of 19 and 11). See Figs. 1-3.

The limitations “for recessing a fastener on a printed wire board (PWB)”, “for interfacing the recessed fastener adapter with the PWB at the fastener hole” and “for accepting and recessing a fastener head” have not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

#### ***Allowable Subject Matter***

5. Claims 11-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The references fail to teach, disclose, or suggest, either alone or in combination, the board interface interfacing with the PWB at the fastener hole; and, wherein the fastener head engaging surface engages a fastener head and recesses a fastener head at least partially below the PWB top surface.

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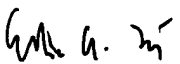
**Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grabbe et al. (U.S. Patent No. 5,073,118), Seidler (U.S. Patent No. 4,932,876), Legrady (U.S. Patent No. 5,154,621), Madden (U.S. Patent No. 3,792,412), Frantz et al. (U.S. Patent No. 5,169,322), and Ackerman (U.S. Patent No. 4585,295) disclose devices having adapters and fasteners.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. León whose telephone number is (703) 308-6253. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Edwin A. León  
AU 2833

EAL  
June 13, 2002

  
**THO D. TA**  
**PRIMARY EXAMINER**